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09/498,856	02/04/2000	Hiroshi Ohnishi	381TO/41092CO	9387
7590	06/29/2004		EXAMINER	
Crowell & Moring LLP Intellectual Property Group PO Box 14300 Washington, DC 20044-4300			ZANELLI, MICHAEL J	
			ART UNIT	PAPER NUMBER
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/498,856

Filing Date: February 04, 2000

Appellant(s): OHNISHI ET AL.

Gary R. Edwards
For Appellant

SUPPLEMENTAL EXAMINER'S ANSWER

This is in response to the remand from the Board of Patent Appeals and Interferences, dated July 31, 2003, to reconsider the rejection under 35 U.S.C. 251 in view of *Ex Parte Eggert et al*, Appeal No. 2001-0790 (Bd. Pat. App. & Inter., May 29, 2003). The previous Examiner's Answer is incorporated herein by reference.

Reissue claims 12-14 stand rejected under 35 U.S.C. § 251 as being an improper recapture of subject matter surrendered during prosecution of the original application. This is the only rejection on appeal.

Background:

In order to obtain allowance of the application that issued as the original patent, one of the following 3 elements was added to each one of independent claims 1, 2 and 4-7 in order to obtain allowance of the original application claims.

1. A limitation directed to "said output torque estimation means..." was added to claims 1, 4 and 5 in the last "wherein clause." Similarly, a limitation directed to "calculating said output torque..." was added to claims 6 and 7 in the last "wherein clause."
2. A limitation directed to "a neural network..." was added to claim 2 in the second-to-last clause.
3. A limitation directed to "vehicle weight estimation means..." was added to claim 2 (last clause), and was also added to claim 4 (second-to-last clause).

The examiner cited each one of the above 3 elements as "Reasons for Allowance".

None of the above 3 elements appear in any of the reissue claims. As explained below, the reissue claims are not directed to a different focus or invention than that originally patented.

Recapture Analysis:

Applicants argue that the reissue claims are directed to subject matter that was not claimed in the original patent. Applicants contend that the "input torque" of reissue claims 12-14 is not the same as the "output torque" of the original patent claims. Referring to column 7 of the original patent, the Appeal Brief (on page 5, 2nd paragraph) states: "[I]n Claim 12 of the present application, the first input torque Tt1 (1014) of Figure 10 and the second input Torque Tt2 (1019) of the same figure are estimated." (Emphasis added). This statement contradicts applicants' assertion that the "input torque" of the reissue claims is different than the "output torque" of the original patent claims. This is so because column 7 of the original patent refers to both components 1014 and 1019 as "a turbine torque." Turbine torque can only be interpreted to be the output torque of the torque converter, whereas the "pump torque" (also referenced in column 7) must mean the engine-driven input torque. This is made all the more clear by the fact that at lines 45-47 of column 7, both elements 1014 and 1019 are referred to as "the turbine output torque".

Applicants further argue that "in the claims of the surrendered patent the construction of element 110 of Figure 10 is the main subject matter, while Claim 12 of the present invention (like Claims 13 and 14) is directed to the construction of element 108 of Figure 10." As pointed out at the bottom of page 6 of the Examiner's Answer, the "wherein" clause of

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original patent claim 1 "describes subject matter related to the structures within element '108' of Figure 10. The "wherein" clause of claim 1 happens to be Element 1 of the three surrender-generating elements omitted from the reissue claims. Element 1 was also added to original patent claims 4-7 in some form.

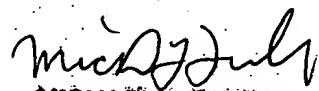
In accordance with the above two paragraphs, the reissue claims are not directed to a different focus or invention than that originally patented. In the present instance, the claims which were rejected by the examiner based on prior art that did not contain any one of Elements 1-3. To overcome the prior art rejection against the claims, the applicants included at least one of the three elements in all the claims. The applicants made the choice of inserting at least one of Elements 1-3 in all of the claims that were allowed in the patent. The applicant chose not to prosecute variations of the original claims excluding all of Elements 1-3. At the present, on reissue, applicant is not permitted to completely exclude these elements by way of the reissue claims.

The decision in *Ex Parte Eggert et al*, Appeal No. 2001-0790 (Bd. Pat. App. & Inter. May 29, 2003) is inapplicable to the instant case as the surrendered subject matter does not appear in any of the claims in an intermediate form (i.e., where surrendered subject matter was omitted, it was entirely omitted). Entire omission of surrendered subject matter in a reissue claim, even if it includes other, unrelated limitations making the reissue claim narrower than the patent claim in other aspects, is impermissible recapture. As stated in *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597, 1601 (Fed. Cir. 2001), "[o]n reissue, [the patent owner] is estopped from attempting to recapture the precise limitation he added to overcome prior art rejections." (Emphasis supplied).

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For the above reasons, it is believed that the rejections should be sustained.

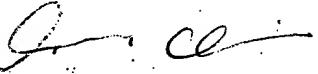
Respectfully submitted,


**MICHAEL J. ZANELLI
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/mjz
June 24, 2004

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